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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,654	04/27/2001	Haruhiko Kinoshita	048369/0123	7693
22428	7590	03/15/2006	EXAMINER	
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			BORLINGHAUS, JASON M	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/842,654	Applicant(s) KINOSHITA, HARUHIKO	
	Examiner Jason M. Borlinghaus	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 10-12, 14 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/27/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/23/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of Claims 1 – 9, 13 and 15 - 16 in the reply filed on 12/16/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Drawings

Figures 2 and 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 2 is objected to because of the following informalities: incorrect wording. Claim 2 (lines 27 – 28) claims "said corporate rating business entity are performing as processing by a computer." (emphasis added). Examiner believes the applicant intends to claim "said corporate rating business entity is performed by a computer."

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 (lines 9 – 10) claims that a corporate rating business entity and application service provider is connected “via an appropriate communication circuit.” (emphasis added). The term appropriate is vague and indistinct.

Claims 2 – 5 are rejected based upon their dependency to Claim 1.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 3628

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 – 9, 13 and 15 - 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Disclosed Prior Art (applicant's specification, pp. 1 – 4) in view of Florzak (Florzak, Douglas. *Successful Independent Consulting. Logical Directions*. Brookfield, Illinois. 1999. pp. 167 – 170).

Regarding Claim 1, Disclosed Prior Art discloses a corporate rating system wherein:

- a corporate rating business entity in a business of performing corporate ratings, one or a plurality of enterprises (specific enterprise) having a relationship with said corporate rating business entity and desiring a corporate rating of itself. (see specification, p. 1, lines 15 – 17); and
- an information source are mutually electrically connected via an appropriate communication circuit (network). (see specification, p. 1, lines 17 – 22); and
- wherein business information indicating general business activities, including at least financial (financial report), accounting (accounting report) and tax information (tax report) for each target enterprise is stored at said information source for each said target enterprise is stored at said information source for each target enterprise. (see specification, p. 1, lines 21 – 27);

Art Unit: 3628

- said system comprising a function whereby said corporate rating business entity having an unique (proprietary) corporate rating software obtains required information with regard to said target enterprise desiring a corporate rating from said information source and performs a corporate rating for said target enterprise using corporate rating software. (see specification, p. 1, line 27 – p. 2, line 2).

Disclosed Prior Art does not teach underlined limitations – a corporate rating system wherein:

- a corporate rating business entity in a business of performing corporate ratings, one or a plurality of enterprises having a prescribed contractual relationship with said corporate rating business entity and desiring a corporate rating of itself; and
- an application service provider (ASP) are mutually electrically connected via an appropriate communication circuit, and wherein business information indicating general business activities, including at least financial, accounting and tax information for each target enterprise is stored at said ASP separately for each said target enterprise;
- said system comprising a function whereby said corporate rating business entity having an unique corporate rating software, obtains required information with regard to said target enterprise in said contractual relationship desiring a corporate rating from said ASP and performs a corporate rating for said target enterprise using corporate rating software.

Forming a contractual relationship between a business entity and an outside entity, such as a consultant, for performance of work on said business entity's behalf is old and well known in the art of business transactions and contract law, as evidenced by Florzak (pp. 167 – 170). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art by incorporating a contractual relationship, as disclosed by Florzak, between the business entity, desiring a corporate rating of itself, and the corporate rating business entity, which would perform said credit rating, as the use of a contract to delineate the relationships, obligations and intent among the parties in said business relationship is a standard and conventional procedure in conducting business transactions.

Utilization of an application service provider for management and use of applications and/or processing of information on a network is old and well known in the arts of information technology. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art and Florzak by incorporating an application service provider to obtain the benefits inherent in the utilization of application service providers such as cost savings.

Regarding Claim 2, Disclosed Prior Art discloses a corporate rating system wherein:

- said operation of obtaining business information indicating general business activities of each enterprise (via computer network) and said operation of performing a corporate rating with respect to each said enterprise at said corporate rating business entity are performed by a

Art Unit: 3628

computer (via proprietary corporate rating method software). (see specification, p. 1, line 15 – p. 2, line 2).

Disclosed Art does not teach underlined limitations – a corporate rating system wherein:

- said operation of transferring to and storing in said ASP business information indicating general business activities of each enterprise and said operation of performing a corporate rating with respect to each said enterprise at said corporate rating business entity are performed by a computer.

Utilization of an application service provider in conjunction with information storage at said provider is old and well known in the art of information technology. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art and Florzak by incorporating the transference and storage of information on an application service provider to allow processing of said information on said application service provider.

Regarding Claim 3, Disclosed Prior Art discloses a corporate rating system wherein:

- use of a communication circuit (computer network/telephone) to obtain an accounting report. (see specification, p. 1, lines 15 – 24); and
- production of accounting report by accounting firm (see specification, p. 2, line 23 – p. 3, line 2).

Art Unit: 3628

Disclosed Prior Art does not teach underlined limitations – a corporate rating system wherein:

- an accounting firm electrically connected to said communication circuit.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art and Florzak by incorporating the ability to connect the accounting firm, whose reports are utilized by the process, as disclosed by Disclosed Prior Art, to the communication circuit already existing, as disclosed by Disclosed Prior Art, allowing for easier transmission of accounting firm generated information to other parties.

Regarding Claim 4, Disclosed Prior Art discloses a corporate rating system wherein:

- said accounting firm views or downloads business information (contained within ledger) indicating general business activities, such as financial, accounting, and tax information of each target enterprise. (see specification, p. 3, lines 14 – 27); and
- based on said business information (ledger), evaluates details of closing account of said enterprise (closing the books). (see specification, p. 3, lines 14 – 27); and
- issues a document certifying the accuracy and appropriateness of details of closing account of said enterprise (see specification, p. 3, line 28 – p. 4, line 2).

Disclosed Prior Art does not teach underlined limitations – a corporate rating system wherein:

- said accounting firm views or downloads business information indicating general business activities, such as financial, accounting, and tax information of each target enterprise;
- using terminal of said accounting firm from said ASP; and
- based on said business information, evaluates details of closing account of said enterprise;
- issues an electronic signature certifying the accuracy and appropriateness of details of closing account of said enterprise; and
- stores said electronic signature at the ASP.

Utilization of an electronic signature for electronically transmitted documents is old and well known in the art of information technology and business transactions. It would have been obvious to have modified Disclosed Prior Art and Florzak by incorporating an electronic signature to provide certification for the information transmitted through the system in the same manner as the accounting firm issues a document to provide certification for the information transmitted through a report, as disclosed by Disclosed Prior Art, to provide an electronic equivalent certification for an electronic equivalent document.

Utilization of an application service provider for management and use of applications and/or processing of information on a network, and storage of information for said processing, is old and well known in the arts of information technology. It would

have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art and Florzak by incorporating a terminal for inputting of information, as the application service provider would be accessed via a network and the use of a terminal for access would be inherent in said network configuration.

Regarding Claim 5, Disclosed Prior Art discloses a corporate rating system wherein:

- said corporate rating business entity refers a signature (accounting firm signature on financial accounting report) and executes a corporate rating evaluation of a prescribed enterprise. (see specification, p. 4, lines 3 – 17).

Disclosed Prior Art does not teach underlined limitations – a corporate rating system wherein:

- said corporate rating business entity refers an electronic signature stored at said ASP, and executes a corporate rating evaluation of a prescribed enterprise.

Utilization of an electronic signature for electronically transmitted documents is old and well known in the art of information technology and business transactions. It would have been obvious to have modified Disclosed Prior Art and Florzak by incorporating an electronic signature to provide certification for the information transmitted through the system in the same manner as the accounting firm issues a document to provide certification for the information transmitted through a report, as disclosed by Disclosed Prior Art, to provide an electronic equivalent certification for an electronic equivalent document.

Utilization of an application service provider for management and use of applications and/or processing of information on a network, and storage of information for said processing, is old and well known in the arts of information technology. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art and Florzak by incorporating a terminal for inputting of information, as the application service provider would be accessed via a network, as disclosed by Disclosed Prior Art, and the use of a terminal for access would be inherent in said network configuration.

Regarding Claims 6 – 9, further method claims would have been obvious from method claims rejected above, Claims 1 – 5, and are therefore rejected using the same art and rationale.

Furthermore, maintaining updated and/or current financial information is old and well known in the art of financial management and record-keeping. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art and Florzak by incorporating the maintenance of updated and/or current financial information concerning the target enterprise to ensure an analysis and/or rating based upon current information, and not old and irrelevant information.

Regarding Claim 13, further method claims would have been obvious from method claims rejected above, Claims 6 - 8, and are therefore rejected using the same art and rationale.

Furthermore, maintaining and/or organizing information concerning separate businesses in separate files is old and well known in the art of financial management and record-keeping. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art and Florzak by incorporating an organization system which maintained information concerning separate businesses in separate files, providing an organization system of information relevant to the contents of the information provided.

Regarding Claims 15 – 16, further computer product claims would have been obvious from method claims rejected above, Claims 6 – 8, and are therefore rejected using the same art and rationale.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3628

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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